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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,065	10/25/2000	Michael A. Brasch	0942.5000001/RWE/BJD	1682

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1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Supplemental Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/695,065	<b>Applicant(s)</b> BRASCH ET AL.	
	<b>Examiner</b> Frank W. Lu	<b>Art Unit</b> 1634	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 14-20, 27, 30-39, 44-51, 56 and 57.  
 Claim(s) withdrawn from consideration: 40-43 and 52-55.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **SUPPLEMENTAL ADVISORY ACTION**

1. The proposed amendments filed on March 29, 2005 have been fully considered but will not be entered because: (1) they raise new issues that would require further consideration and/or search; and (2) they present additional claims without canceling a corresponding number of finally rejected claims. This office action is used to correct some errors in previous office action mailed on April 20, 2005 and said previous office action is hereby withdrawn.

#### ***Response to Arguments***

I. In page 14, second paragraph of applicant's remarks, applicant states "[D]uring the interview, the Examiner suggested that replacement of the term 'integration sequences' with the term 'mobile genetic element' would be favorably received. The Examiner agreed to reconsider the cited references in light of the recitation of 'mobile genetic element' in the claims".

Although applicant changes "integration sequences" with the term "mobile genetic element" in the proposed amendment on independent claims 14, 16, and 44, the rejections under 35 USC 102 should be maintained because "mobile genetic element" is defined as any genetic unit that can insert into a chromosome, exit, and relocate (see attached definition for "mobile genetic element" in previous office action mailed on April 20, 2005).

II. In page 14, last paragraph bridging to page 18, first paragraph of applicant's remarks, applicant argues that the amendments have overcome three rejections under 35 U.S.C 102.

This argument has been fully considered and is moot since independent claims 14, 16, and 44 are amended by changing the phrase "integration sequences" to "mobile genetic

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elements". This new amendment in claims 14, 16, and 44 raises new issues that would require further consideration and/or search.

III. Related to arguments in page 18, second and third paragraph of applicant's remarks, the examiner agrees to withdraw the rejection under 35 U.S.C 102 (f).

IV. In page 18, fourth paragraph bridging to page 19, first paragraph of applicant's remarks, applicant argues that claims 14-20, 27, 32-39, 44-51, and 57 should not be rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27-39 of U.S. Patent NO.5,888,732.

This argument has been fully considered and is moot since claims independent claims 14, 16, and 44 are amended by changing the phrase "integration sequences" to "mobile genetic elements". This new amendment in claims 14, 16, and 44 raises new issues that would require further consideration and/or search.

2. Note that applicant presents additional claims (newly added claims 58-79) without canceling a corresponding number of finally rejected claims.

3. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.



Frank Lu  
PSA  
May 20, 2005

**FRANK LU**  
**PATENT EXAMINER**